

Regarding claim 1, Shimotsuji teaches a data input form retrieving system comprising: . . . extracting conditions input means for inputting a condition of extracting a specific data input form out of the plural data input forms . . . see column 2, line 15-17) . . .

The Request for Reconsideration filed July 22, 2003, explicitly provided arguments rebutting this assertion. Those arguments are found on page 2, second through fifth paragraphs, of that Request for Reconsideration.

Under these circumstances, i.e., where the same ground of rejection is repeated, the Administrative Procedures Act and PTO policy, including the Manual of Patent Examining Procedure, Section 707.07(f), entitled "Answer All Material Traversed," require the next Office Action to address Applicants' arguments presented in response to the same ground of rejection in the previous Office Action.

Because this Office Action has not answered Applicants' four paragraphs of arguments directed to this ground of rejection, the outstanding rejection should be withdrawn and a new Office Action prepared and mailed to Applicants.

Turning to the merits of the rejection, Applicants repeatedly reassert the unanswered traversal of this ground of rejection. Contrary to an assertion in the Office Action, Shimotsuji does not disclose "extracting conditions input means for inputting a condition of extracting a specific data input form out of the plural data input forms" as recited in claim 1.

In column 1, lines 37-39, Shimotsuji merely discloses "a plurality of form data registered in the file memory are displayed in order and the user selects one form in which he wants to observe the document." This relates to displaying form data, not to a condition of extracting a specific data input form out of plural data input forms. No conditions are specified in Shimotsuji. Rather, the user selects one of the displayed forms.

In column 2, line 15, Shimotsuji discloses "image input means for inputting image data of a new document." This simply discloses that Shimotsuji has a means to input image

data for a new document. This only concerns having an image input means and has nothing to do inputting extracting conditions.

Thus, Shimotsuji does not disclose "extracting conditions input means for inputting a condition of extracting a specific data input form out of the plural data input forms," as recited in claim 1.

The Office Action then admits that "Shimotsuji does not explicitly disclose extracting condition and inputting condition."

Applicants do not fully understand this assertion because, although claim 1 recites "extracting conditions" in the context of "extracting conditions input means," claim 1 does not recite "inputting condition." Accordingly, the Office Action is directed to a feature which is not positively recited in claim 1.

Thus, the Office Action is unclear concerning whether or not Shimotsuji is considered to disclose an "extracting conditions input means" as well as "a condition of extracting a specific data input form out of the plural data input forms," as recited in claim 1.

Moreover, because Shimotsuji does not disclose the extracting conditions input means, for the reasons stated above, Shimotsuji does not disclose "data input extracting means for extracting the specific data input form by retrieving the character string extracted by the character string extracting means in accordance with the extracting conditions inputted by the extracting condition input means," as recited in claim 1.

The Office Action then turns to Kumagai because Kumagai allegedly "discloses extracting condition and inputting condition." However, as noted above, this is not what is recited in claim 1.

Kumagai is directed to a data processing system in an image recognition system or an acoustic recognition system - see col. 1, lines 14-16. Col. 2, lines 27-31 indicate that the data processing system may be located in a system for recognizing a letter/character inputted from

a video camera. Kumagai discloses a characteristics value settlement circuit 304 that settles the condition of characteristics variables such as "what kind of data to be extracted" for instance, "the number of pixels."

The Office Action concludes that it would be obvious to combine Kumagai with Shimotsuji. These two references are said to be combined "wherein extracting condition and inputting condition define the extracting condition of input data such as 'on what kind of condition input data is to be extracted. '"

Unfortunately, the Office Action never states what part of Shimotsuji is to be modified and how it is to be modified, or how Kumagai's characteristics value settlement circuit 304 will work in Shimotsuji. A rejection must be based on a factual basis, not a speculative basis, and an Applicant should not be left to speculate on how the references are to be combined in the rejection, as is the situation here.

Additionally, the office Action never explains why Shimotsuji needs to be modified. In this regard, Shimotsuji discloses extracting character-line extraction means for extracting line data and character data from the input image data - see col. 1, lines 54-58, for example. As such, Shimotsuji has no need for Kumagai's "characteristics value settlement circuit 304." In other words, because Shimotsuji has already determined what kind of data is going to be extracted, i.e., that it is going to extract existing line data and character data from the input image data, Shimotsuji does not have a need to be modified to include "characteristics value settlement circuit 304."

The Office Action asserts that one of ordinary skill in the art would be motivated to combine Kumagai and Shimotsuji because "these conditions retrieve the items of interest from the database at high speed without the use of conventional index."

Applicants respectfully submit that this rationale puts the cart before the horse by stating what will allegedly result from the combination after it has been made. In this regard,

Applicants respectfully disagree with the Office Action as to what will result if these two references are combined, for the reasons stated above. This statement of what will result from the reference combination is substantially different from stating a proper motivation to combine these references, and is based on improper hindsight reconstruction of the invention solely based on Applicants' teachings. Moreover, neither applied reference discusses the benefits of retrieving items of interest without the use of a conventional index. As a result, it is not clear why retrieving items without a conventional index provides a motivation to combine these references.

Thus the Office Action fails to demonstrate why a person skilled in the art would have been motivated, i.e., have the incentive, to modify Shimotsuji in view of Kumagai to achieve the claimed invention.

The assertions in the Office Action regarding the rejection of independent claims 5 and 9, which recite method features similar to the features recited in claim 1, are similarly inapposite and unsupported.

In summary, neither Shimotsuji nor Kumagai disclose the second and third positively recited clauses in the body of claims 1, 5 and 9; the Office Action does not provide proper evidence of motivation to modify Shimotsuji to achieve the invention recited in claims 1, 5 and 9; the Office Action fails to address the invention recited in claims 1, 5 and 9 in regard to the alleged modification of Shimotsuji; the Office Action fails to indicate how Shimotsuji would be modified by Kumagai's characteristics variable settlement circuit 304 to result in the invention recited in claims 1, 5 and 9, and, the proposed modification of Shimotsuji, even if proper, would not render the invention recited in claims 1, 5 and 9 obvious.

Claim 2-3 depend from claim 1 and are patentable at least for the reasons that claim 1 is patentable, as set forth above.

Claims 5 and 9 recite method steps which are similar to the apparatus features recited in claim 1, and are patentable for the reasons that claim 1 is patentable.

Claims 6-7 depend from claim 5 and are patentable at least for the reasons that claim 5 is patentable, as set forth above.

Claims 10-11 depend from claim 9 and are patentable at least for the reasons that claim 9 is patentable, as set forth above.

Accordingly, the rejection of claims 1-3, 5-7 and 9-11 under 35 USC §103(a) over Shimotsuji in view of Kumagai is improper and should be withdrawn.

Regarding claims 4, 8 and 12, Shimotsuji does not disclose extracting condition input means for inputting a condition of extracting a specific data input from out of the plural data input forms, for the reasons stated above.

Nor does Shimotsuji provide means for adding a keyword to each of plural data input forms, as recited in claim 4. This feature is not found in either Shimotsuji or Kumagai.

Rather, Shimotsuji merely states, in col. 1, lines 35-36, upon which the rejection is based, that prior art data retrieval methods involve inputting a predetermined keyword to retrieve data desired by a user. While this may be a disclosure of inputting a keyword to a computer, this is definitely not a teaching of adding a keyword input to each of plural data input forms.

The rejection does not even allege that Kumagai discloses this feature.

As noted above, evidence of motivation must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617. There is no such evidence of record, especially because neither Shimotsuji nor Kumagai provides such evidence. In this regard, it is also noted that a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusionary statements of the

Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). As neither Shimotsuji nor Kumagai even suggests doing what is allegedly obvious to do, the motivation for modifying Shimotsuji must be based on improper speculation and/or impermissible hindsight.

Finally, even if the references were properly combined, which they are not, they would not result in the invention recited in claims 4, 8 and 12, for reasons stated herein.

In summary, neither Shimotsuji nor Kumagai disclose a number of positively recited clauses in claims 4, 8 and 12; the Office Action does not provide proper evidence of motivation to modify Shimotsuji to achieve the invention recited in claims 4, 8 and 12; and the proposed modification of Shimotsuji in view of Kumagai, even if proper (which it is not), would not render the invention recited in claims 4, 8 and 12 obvious.

Accordingly, the rejection of claims 4, 8 and 12 under 35 USC §103(a) over Shimotsuji in view of Kumagai is improper and should be withdrawn.

In view of the foregoing, it is respectfully submitted that claims 1-12 are in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-12 are earnestly solicited.